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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,558	03/22/2001	Lawrence H. Lazarus	209897	4487

23460 7590 02/07/2003

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EXAMINER

LUKTON, DAVID

ART UNIT PAPER NUMBER

1653

DATE MAILED: 02/07/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/814,558

Applicant(s)

LAZARUS ET AL.

Examiner

David Lukton

Art Unit

1653

-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 19 is/are rejected.
- 7) ☒ Claim(s) 2-10 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Pursuant to the directives of paper No. 9 (file 3/25/02), claims 10 and 20 have been amended. Claims 1-20 are pending, of which claims 11-18 remain withdrawn from consideration.

Applicants arguments filed 3/25/02 have been considered and found persuasive.

*

The abstract is objected to on grammatical grounds. A grammatically complete sentence contains both a "subject" and a "predicate". In simplest form, either of the following could be used: *Compounds of the formula are disclosed* - or - *A compound of the formula is disclosed.* The following format is suggested:

Compounds of the formula

{formula as recited}

which comprise the Dmt-Tic pharmacophore are disclosed herein. The compounds are agonists and antagonists of the ... [etc.]

*

The following is a quotation of the appropriate paragraphs of 35 U.S.C §102 that form the basis for the rejections under this section made in this action.

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2) and (4) of section 371(c) of this title before the invention thereof by the applicant for the patent.

Claims 1 and 19 are rejected under 35 U.S.C. §102(b) as being anticipated by Lazarus (*Drug Devel Today* 3, 284, 1998).

Lazarus discloses compound #37 (page 288). This anticipates claim 1 for the case of instant variable R' being Me₂N, and variable R" being carboxyl.

Thus, the claim is anticipated.

✱

Claims 1 and 19 are rejected under 35 U.S.C. §102(a) as being anticipated by Lazarus (*Int Symp Pept Chem Biol*, 24-29, 1999; reference "BD" on the IDS).

Lazarus discloses various compounds falling within the scope of the claimed genus, such as the following:

N,N(Me)₂-Dmt-Tic-OH

The inventive entity of the instant application differs from that of the reference, despite the

presence of inventors in common. As such, the claim is anticipated.

*

Claims 1 and 19 are rejected under 35 U.S.C. §102(a) as being anticipated by Lazarus (*J Med Chem* **42**, 5010, 1999).

Lazarus discloses (figure 1) various compounds falling within the scope of the claimed genus, such as the one in which R₁ is piperidine, and R₂ is carboxyl (reference variables). The inventive entity of the instant application differs from that of the reference, despite the presence of inventors in common. As such, the claim is anticipated.

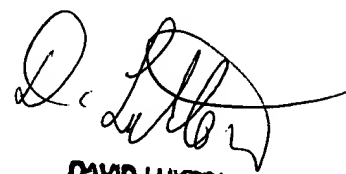
*

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 703-308-3213. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached at (703) 308-2923. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


DAVID LUKTON
PATENT EXAMINER
GROUP 1203